

REMARKS

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-12 are pending in the application, with claim 1 being the independent claim, and new, dependent claims 12 and 13 being added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above Amendment and the following Remarks, the Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1,2, and 7-10 were rejected under 35 U.S.C. section 102(b) as being anticipated by U.S. Patent No. 5,642,426, to Neuman, et al., (“Neuman”). Specifically, the Examiner alleges Neuman describes an integral radio and infrared assistive listening device comprising a base housing (11) constructed and arranged to support a decoder means (102), a FM radio receiver (14), replaceable power source (13), and a volume control (12) enclosed in the housing (11). (Office Action, December 10, 2003, p. 2)

As described in the specification, the present application is directed to a circuit housing for a head set. The housing 8 has a cover 24 over the front face of the housing. Rotating the cover 24 actuates potentiometer 26 of electrical circuit 28. Claim 1 of the application, which is the only independent claim, is directed to a circuit housing having a cover which actuates the electrical circuit.

A claim is anticipated under 35 U.S.C. section 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Moreover, elements must be arranged as required by the claim. *See In re Bond*, 910 F.2d 831(Fed. Cir. 1990).

In order for Neuman to anticipate claim 1 under 35 U.S.C. section 102(b), Neuman must set forth each and every element of the claim, with such elements arranged the same way as claimed by the Applicant. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989), *In re Bond*, 910 F.2d 831(Fed. Cir. 1990). In this case, Neuman, does not teach each and every element of claim 1.

Neuman describes a hearing device with a housing 11. The housing 11 encloses the necessary electronics for converting IR or FM signals into audio signals. (col. 5, ll. 50-52). In Fig. 5, Neuman illustrates actuating elements *in* a housing (11), namely a volume control (9), selector switch (10), and an on/off switch (20). (col. 5, ll. 54-56,)(emphasis added). In Fig. 1, Neuman illustrates a volume control 12, and an infrared or FM receiver 14 exposed by aperatures in the front wall (17). (col. 3, ll. 45-55). In Figs. 7 and 8, Neuman illustrates a volume control (109) and a tuning control (107) projecting through housing (112). Neuman's housing is clearly just an exterior that encloses other components, including actuating elements. Neuman's housing does not move or otherwise actuate anything itself.

The examiner has interpreted Neuman to have a housing which is the same as applicant's cover. However, applicant's cover 24 rotationally actuates the potentiometer of the circuit. In order for Neuman's housing to be the same as applicant's cover, Neuman's housing would have to actuate one or more circuits. However, Neuman's housing is simply a shell enclosing actuators and other components of the device. Thus, Neuman does not disclose a cover as claimed by the Applicant.

Since Neuman does not disclose all of the elements of applicant's claim 1, namely a cover, claim 1 is not anticipated by Neuman. Moreover, claim 1 sufficiently distinguishes the claimed invention over the prior art, such that all the elements of dependent claims 2 and 7-10 are not described, and are thus also allowable. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). For these reasons, applicant respectfully requests the Examiner to withdraw the rejection of claims 1, 2, and 7-10.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 3, 5, 6 and 11 under 35 U.S.C. § 103(a) as obvious in light of Neuman and the knowledge of one of ordinary skill in the art, and has rejected claim 4 under 35 U.S.C. § 103(a) under Neuman in view of Re. 34,236 to Taylor ("Taylor"). To present a *prima facie* case of obviousness, there must be a reasonable expectation of success and the combined references must teach or suggest all the claim limitations. *See In re Veach*, 947 F.2d 488(Fed. Cir. 1991), M.P.E.P. §706.02(j).

a.) Rejection of claim 3

Particular to claim 3, the Examiner alleges that Neuman meets all the elements of Applicant's claim 3 except for the cover having a scale which cooperates with a marking on the housing. The Examiner argues that volume scales are well-known, that Neuman's housing operates as a cover, and that it would be obvious to combine a volume scale that cooperates with a marking on the housing. As previously discussed herein, Neuman does not describe a cover as claimed by the Applicant. Further, if Neuman's housing is the cover, it could not *cooperate* with a housing, because it is one structure. Thus, combining Neuman with the well known volume controls would still not provide a successfully working apparatus as that claimed by the Applicant. Since the combination of Neuman and the ordinary skill in the art does not disclose or successfully combine to make applicant's invention, claim 3 is not obvious under 35 U.S.C. § 103(a).

b.) *Rejection of claims 5, 6, and 11*

The Examiner has rejected claims 5, 6 and 11 under 35 U.S.C. § 103(a) as obvious in light of Neuman and the knowledge of one of ordinary skill in the art. In order to be obvious, the combined references must teach or suggest all the claim limitations.

See In re Veach, 947 F.2d 488(Fed. Cir. 1991), M.P.E.P. §706.02(j). As previously discussed herein, Neuman does not describe a cover as claimed by the Applicant. Thus, combining Neuman with the knowledge of one of ordinary skill in the art still does not teach or suggest all of the Applicant's claim limitations. Since the suggested combination does not teach or suggest the necessary elements to meet a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the rejection of claims 5, 6 and 11 should be withdrawn.

c.) *Rejection of Claim 4*

Claim 4 was rejected under 35 U.S.C. § 103(a), as obvious under Neuman in view of Taylor. Particularly, the Examiner argues that Neuman meets all elements of claim 4 except the cover being connected to a potentiometer of the circuit by a slipping clutch. The Examiner argues that Taylor discloses a headphone comprising a voltage adjustment potentiometer, that something must connect the potentiometer to the volume control, and a clutch grips or holds things, so it would be obvious to connect Taylor's potentiometer to a volume control on a cover with a slipping clutch.

The Examiner's argument impermissibly adds an element or structure, namely a clutch, that is not disclosed by either Taylor or Neuman. First, Taylor does not disclose any structure for connecting potentiometer (50). Unless common knowledge in the art is instantly and unquestionably well-known, the Examiner must provide evidentiary support of such common knowledge. *See In re Ahlert*, 424 F.2d 1088, (CCPA 1970). If facts supporting the state of the art are subject to rational disagreement, evidentiary support of such facts is needed to make a *prima facie* case of obviousness. *See In re Eyned*, 480 F.2d 1364, 1370 (CCPA 1973), M.P.E.P. §2144.03. In order to say that connecting a clutch, and much less a slipping clutch, is well-known for connecting potentiometers, there must be no other connector that could rationally be used. Referring to attached Exhibit A, however, we see that potentiometers can be mounted with a wide variety of structures, including bushings, twist tabs, bend tabs, snap-in PC brackets, solder lug terminals, ear mounts, hex nuts and lock washers, and pin terminals. Many of these connecting devices are not clutches. Thus applicant disagrees with the Examiner's characterization of ordinary skill. Further, even if you combined Neuman and Taylor, the result is unknown. Since the resulting structure is unknown, it cannot teach or suggest all

the claim limitations. Therefore, the rejection of claim 4 under 35 U.S.C. § 103(a) is improper for failing to teach all of the limitations of Applicant's claim 4.

Additionally, the combination of Neuman and Taylor is improper because there is no suggestion to combine the two references. References cannot be properly combined unless the prior art suggest the desirability of the combination. *See, e.g., In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Neuman's headset is designed to be portable, and carried in a case no bigger than an eye glass case. (Neuman, col. 2, ll. 18-23.). On the other hand, Taylor's system is a pneumatic system designed for providing attenuated music or other program material as well as two-way communication between an operator, in one location, and a patient separated from the operator and resting within a Nuclear Magnetic Resonance (NMR) machine. (col. 1, ll. 50-55). Taylor's system includes a microphone, speakers, and connects to pneumatic tubes extending to a patient in another room. In the NMR environment, electrical signals and the use of metallic objects can adversely affect the machine's operation. (col. 1, ll. 55-66). Taylor's potentiometer (50) is used to control microphone volume. (col. 3, ll. 60-66). The microphone would necessarily be located with the operator outside of the scan room. (col. 1, ll. 50-55). Structures used in Taylor would not necessarily even be of appropriate size, material, or design to be considered for use with Neuman. Thus, there is no suggestion or motivation to combine Neuman and Taylor. Since the refusal is not supported by a motivation or suggestion to combine the cited references, the refusal of claim 4 under 35 U.S.C. §103(a) is improper and should be withdrawn.

Additionally, as noted in prior arguments, the rejection of claim 4 under 35 U.S.C. § 103(a) as obvious under Neuman in view of Taylor is improper because Neuman does

not disclose a cover as claimed by the Applicant. Since the combined references do not teach or suggest all the claim limitations, the rejection under 35 U.S.C. § 103(a), is improper in this case.

For the foregoing reasons, Applicant respectfully requests the Examiner to withdraw the rejections of claims 3, 4, 5, 6, and 11 under 35 U.S.C. § 103(a).

Miscellaneous

Other amendments to the specification and/or claims have been effected merely for editorial purposes. In all cases, amendments are not intended to waive any rights available to the applicant to further pursue claims to the subject matter of this application in continued prosecution.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, addressed, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,

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